

REMARKS

By this Amendment, Applicants amend claim 1 to more appropriately define the present invention. Claims 1-20 are pending in this application, with claims 1-5 under current examination and claims 6-20 withdrawn from further consideration as a result of the final restriction requirement.

Regarding the Office Action:

In the Office Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 101; rejected claims 3-5 under 35 U.S.C. § 112; rejected claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Pickering (U.S. Patent No. 5,684,965); and rejected claims 1, 3, and 5 under 35 U.S.C. § 103(a) as unpatentable over Pickering as applied to claims 1-4, and further in view of Hilt et al. (U.S. Patent No. 5,465,206). Applicants appreciate the Examiner's examination of this application. Nevertheless, Applicants respectfully traverse these rejections.

Regarding the Rejection of Claims 1-5 Under 35 U.S.C. § 101:

Applicants amend claim 1 to incorporate technological arts sufficient to constitute application of useful arts. Applicants submit that "[a]n electronic billing method" achieves a tangible use and respectfully request withdrawal of rejection of claims 1-5 under 35 U.S.C. § 101.

Regarding the Rejection of Claims 3-5 Under 35 U.S.C. § 112, Second Paragraph:

Applicants respectfully point out to the Examiner that a claim is allowable if the claim defines the patentable subject matter "with a reasonable degree of particularity and distinctness," "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." M.P.E.P. § 2173.02. The fact that a claim is broad does not mean that it is indefinite. In response to the Examiner's

question, the claim language would cover either situation noted by the Examiner, as well as others. The claim language is not indefinite. Applicants respectfully request withdrawal of rejection of claims 3-5 under 35 U.S.C. § 112, Second Paragraph.

Regarding the Rejection of Claims 1-4 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Pickering. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claim 1, as amended, calls for a combination including, for example, “receiving in a computer at least one electronic billing request from a customer, the request identifying at least a first billing entity and a second billing entity.” Pickering fails to teach at least “receiving in a computer at least one electronic billing request from a customer, the request identifying at least a first billing entity and a second billing entity,” as required by claim 1. Pickering teaches “enrolling specific customers,” “[i]f a customer is interested in participating in the program, the customer contacts the financial firm (usually by telephone) and provides information” Pickering, col. 3 lines 52-65. Therefore, in Pickering, the contact is made by the customer by telephone for the purpose of enrollment and account setup. Such teaching does not constitute “receiving in a computer at least one electronic billing request from a customer . . . ,” as required by claim 1.

Therefore, Applicants submit that a prima facie case of obviousness is not established and claim 1, as amended, is nonobvious under 35 U.S.C. § 103(a) over Pickering. Furthermore, “[i]f an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03, quoting In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Because claims 2-4 depend on claim 1, Applicants submit that claims 2-4 are also nonobvious under 35 U.S.C. § 103(a) over Pickering. Applicants respectfully request withdrawal of rejection of claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Pickering.¹

Regarding the Rejection of Claims 1, 3, and 5 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 1, 3, and 5 under 35 U.S.C. § 103(a) as unpatentable over Pickering in view of Hilt et al.

Claim 1, as amended, calls for a combination including, for example, “receiving in a computer at least one electronic billing request from a customer, the request identifying at least a first billing entity and a second billing entity.” As set forth above, Pickering fails to disclose at least “receiving in a computer at least one electronic billing request from a customer, the request identifying at least a first billing entity and a second billing entity,” as required by the amended claim 1.

Hilt fails to cure Pickering’s deficiency. Hilt teaches an electronic bill pay system through which a consumer could pay a biller through the consumer’s bank. See Hilt, abstract. In

¹ The Examiner’s statement that Pickering teaches Step 21 as “executing a single instance of a bill presentment and payment application” is not supported by the reference. (Office Action, pp. 6-7.) In Pickering, Step 21 “generating single customer utility bill” does not constitute “using the single instance of the bill presentment and payment application [software],” as defined in the specification.

Hilt, after a consumer receives a bill directly from a biller, the consumer could authorize a remittance from the consumer's bank. To do that, the "consumer transmits to its bank a bill pay order indicating . . . the biller's biller identification number," and the bank then forwards the payment "to the biller's bank." Hilt, abstract. As such, the bank does not have billing information from the biller, the bank merely transfers funds from the consumer's account to the biller's bank,² furthermore, no multiple billers are involved in a single transaction. Therefore, Hilt's teaching on the electronic bill pay system does not constitute a teaching of "receiving at least one online billing request from a customer, the request identifying at least a first billing entity and a second billing entity," as required by the amended claim 1.

Therefore, neither Pickering nor Hilt, taken alone or in any reasonable combination, disclose all elements of Applicants' invention as recited in amended claim 1. Applicants submit that claim 1 is nonobvious under 35 U.S.C. § 103(a) over Pickering in view of Hilt and the rejection of claim 1 should be withdrawn. Since claims 3 and 5 depend on claim 1, Applicants further submit that claims 3 and 5 are also nonobvious under 35 U.S.C. § 103(a) over Pickering and the rejection of claims 3 and 5 should be withdrawn.³

² Hilt does not teach "to sporadically check on the status on one's account," (Office Action, p. 8), because the bank does not have access to biller's account information. Therefore, the Examiner's reasoning on Hilt's suggestion to modify Pickering's teaching "to include an interface which allows one to check one's account" is not supported by the reference.

³ Applicants also respectfully point out that "a symbol or trademark identifying banks and billers . . ." as described in Hilt, col. 17 line 41 does not constitute the "implementation object" as illustrated in FIG. 2, because an instance of computer software implementation is invisible outside the computer therefore is not able to be "a symbol or trademark."

Conclusion

In view of the foregoing, Applicants submit that the rejection is not supported by the prior art references cited by the Examiner. Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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